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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,949	06/25/2003	Dirk Palenik	60027.0190USU1/BS# 030078	3137
39262	7590	11/06/2006	EXAMINER	
MERCHANT & GOULD BELLSOUTH CORPORATION P.O. BOX 2903 MINNEAPOLIS, MN 55402			WILSON, YOLANDA L	
			ART UNIT	PAPER NUMBER
			2113	

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/603,949

Applicant(s)

PALENIK ET AL.

Examiner

Yolanda L. Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-10, 15, 16 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15, 16 and 37 is/are allowed.
- 6) ☒ Claim(s) 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant states in the newly added limitation in claim 7 'wherein the computer system includes an external network'. The Examiner is unsure as to what is being referred to here. An external network cannot be included in a computer system. Either the computer system needs to be included in an external network or an external network interface/external communications interface needs to be claimed here. Claims 8-10 are rejected as well for being dependent upon claim 7.

***Allowable Subject Matter***

3. Claims 15,16,37 are allowed.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 7,9,10 are rejected under 35 U.S.C. 102(b) as being anticipated by Westell.
6. As per claim 7, Westell discloses Westell discloses at the computer system, utilizing a computer-implemented application to perform one or more checks on the

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computer system and communications device; at the computer system, detecting from the one or more checks whether there is a problem related to operation of the communications device with the computer system; at the computer system, locating a troubleshooting tip corresponding to the problem detected from the one or more checks; at the computer system, displaying the located troubleshooting tip on pages 24-26, under the Diagnostics section and on pages 44-48, under the Troubleshooting section. The computer-implemented application is the diagnostics pages that contain all of the tests to be performed on the computer system for the modem. The error code is the message displayed after the test is performed.

The limitation wherein the computer system includes an external network is disclosed on page 1, under Minimum System Requirements. Examiner is assuming that the computer system needs an external communications interface/external network interface. In this case it is an Ethernet connection which is disclosed that the computer system the modem is connected has to have.

7. As per claim 9, As per claim 4, Westell discloses wherein the one or more checks includes checking operational parameters of the communications device on page 25, under the Diagnostics section.

8. As per claim 10, Westell discloses wherein the communications device is a digital subscriber line modem on page 25, under the Diagnostics section.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westell in view of Li et al. (US Publication Number 20040078708A1).

11. As per claim 8, Westell fails to explicitly state wherein the one or more checks includes checking a connection between the computer system and the communications device.

Li et al. discloses this limitation on page 2, paragraph 22, lines 10-15.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the one or more checks include checking a connection between the computer system and the communications device. A person of ordinary skill in the art would have been motivated to have the one or more checks include checking a connection between the computer system and the communications device because a determination as to whether or not a cable is properly connected to the computer and modem is made.


### ***Response to Arguments***

12. Applicant's arguments with respect to claims 7-10 have been considered but are moot in view of the reference Westell used to reject the added limitation in claim 7.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yolanda L. Wilson whose telephone number is (571) 272-3653. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on (571) 272-3645. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Yolanda L. Wilson  
Examiner  
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